

### REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed January 12, 2005. At the time of the Final Office Action, Claims 1-16 and 18-22 were pending in this Application. Claim 17 was previously cancelled by Applicants. Claims 1-8 and 10-14 were rejected, Claim 9 was objected to, and Claims 15, 16, and 18-22 were allowed. Claims 1-14 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. §112**

Claim 3 was rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claim 3 to overcome these rejections and respectfully request full allowance of said Claim as amended.

#### **Rejections under 35 U.S.C. § 102**

Claims 1-3 and 5 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,396,692 issued to Jasmin B. Farshi et al. ("Farshi"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention. Claim 1 has been amended to particularly claim an embodiment of the invention. Specifically, Claim 1 has been amended to make clear the top surface of the heat conduction metal plate body is integrated into the plastic control plate such that the top surface of the heat conduction metal plate body is flush with the top surface of the plastic control plate. (Old Claim 6, now cancelled but previously searched.) It is respectfully submitted Farshi fails to disclose such a system. (Compare, *e.g.* Figure 1 of the present application with Figure 3 of Farshi.) Withdrawal of the rejection is requested.

Claims 1, 3-5, 7, 8 and 11-13 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,276,584 issued to Hugh M .Collins et al. ("Collins"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention. The presently claimed embodiment of the

invention is directed, *inter alia*, to a plastic control plate with at least one channel *running through* the plastic control plate, *e.g.* the channel is bounded on at least one side by the plastic control plate. See Figures 1, 3 and 5 of the present application. Collins discloses a complicated and difficult to manufacture heat sink structure with multiple channels running through the *heat sink*, not through a plastic control plate. See Figure 6 of Collins, channel 30 of heat sink 26. Thus, Applicants request withdrawal of the rejection and favorable action.

### **Rejections under 35 U.S.C. §103**

Claims 2 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Collins in view of Farshi. Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. Neither Collins nor Farshi disclose a heat conduction metal plate body flush with the plastic plate and/or channels bonded at least on one side by the plastic plate.

Claims 1-4, 7, 8, and 10-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent DE 197 15 592 filed by Spiess et al. ("Spiess") in view of Farshi. Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. Spiess fails to teach a channel through a plastic control plate. Channel 5 cited by the Examiner does not run through a plastic control plate but runs instead between electronics box 8 and housing 1. Moreover, Spiess fails to teach an electronics system arranged directly on the upper surface of the heat conduction metal plate body as claimed. Farshi's teaching of an aluminum plate fails to fill the above-noted gaps of Spiess. Withdrawal of the rejection is requested.

Claims 1, 3, 4, 7, 8, 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Spiess in view of Collins. Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. See above comments regarding Spiess and Collins.

Claims 1, 6, 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,160,708 issued to Josef Loibl et al. ("Loibl") in view of Farshi. Applicants

respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. Neither Loibl nor Farshi disclose a plastic control plate with a channel running through the plastic control plate bounded on at least one side by the plastic control plate, and on another side by a heat conduction metal plate body wherein, *e.g.*, electronics are in communication with said body. Withdrawal of the rejection is requested.

Claims 1, 6, 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Loibl in view of Collins. Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. See above comments regarding Loibl and Collins.

It is axiomatic that in order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Here, as noted above, the requirements to establish a *prima facie* case of obviousness are not present. Namely, the cited art combinations, as noted above, fail to teach or suggest all the claim limitations. Withdrawal of the rejections is respectfully requested.

#### **Information Disclosure Statement**

Applicants would like to bring to the Examiner's attention that Applicants filed an Information Disclosure Statement on January 21, 2005. Applicants respectfully request that the Information Disclosure Statements be considered and cited in the examination of the above-referenced application. Applicants attach a copy of the Information Disclosure

Statement and PTO Form 1449 filed January 12, 2005 for the Examiner's convenience and a copy of the postcard receipt evidencing receipt by the Patent Office.

**Allowable Subject Matter**

Applicants appreciate the Examiner's allowance of Claims 15, 16, and 18-22.

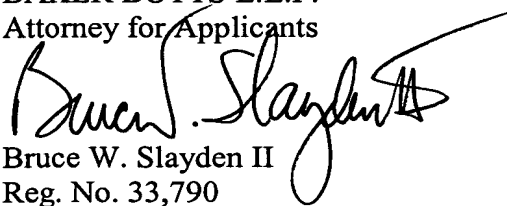
**CONCLUSION**

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

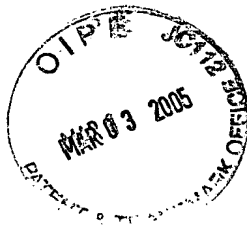
If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,  
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Attorney for Applicants

  
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Date: 3/3/2005



The "Received" stamp of the Patent and Trademark Office imprinted hereon acknowledges the filing of:

Application - Spec., Claims, Abstract (___ Page(s))	<input type="checkbox"/> Verified Statement (___ Page(s))
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Declaration(s)/Power(s) of Attorney (___ Page(s))	<input checked="" type="checkbox"/> Check No. <u>68532</u> Amt.: \$ <u>180.00</u>
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<input type="checkbox"/> Non-Publication Request (___ Page(s))	

Inventor(s): **Roland Albert et al.**

Serial No.: **10/616,018**

Receipt Date & Serial No.:

Title: **Plastic Control Plate of a Hydraulic Gearbox Control Device in a Motor Vehicle**

Client/Applicant: **Siemens AG**

BB File No.: **071308.0446**

Mailed: **1/21/05**

Certificate of Mailing

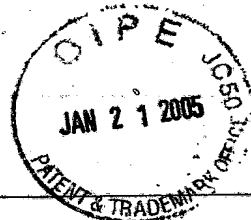
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ATTORNEY DOCKET  
071308.0446



PATENT APPLICATION  
10/616,018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Roland Albert et al.  
Serial No.: 10/616,018  
Date Filed: July 9, 2003  
Group Art Unit: 3682  
Examiner: Chong Hwa Kim  
Title: *Plastic Control Plate of a Hydraulic Gearbox  
Control Device in a Motor Vehicle*

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV351287439US on an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

  
Angela Loding

January 21, 2005

Date

Dear Sir:

**INFORMATION DISCLOSURE STATEMENT**

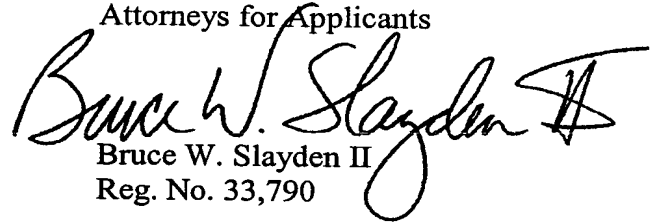
Applicants respectfully request, pursuant to 37 C.F.R. §§1.56, 1.97 and 1.98, that the references listed on the attached PTO-1449 form be considered in the examination of the above-identified patent application. Since the present Application was filed after June 30, 2003, a copy of any U.S. Patent and any U.S. Patent Application Publication cited on the attached PTO Form 1449 is not being submitted with this Information Disclosure Statement pursuant to the July 11, 2003 waiver of 37 C.F.R. §1.98(A)(2)(i) by the U.S. Patent and Trademark Office.

Furthermore, pursuant to 37 C.F.R. §§1.97(g) and (h), no representation is made that these references are material to the patentability of the present application.

Applicants enclose a check in the amount of \$180.00 with this Information Disclosure Statement however, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants

  
Bruce W. Slayden II  
Reg. No. 33,790

Date: January 21, 2005

SEND CORRESPONDENCE TO:

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PTO-1449

**Information Disclosure Citation  
in an Application**

Application No.

Applicant(s)

10/616,018

Roland Albert et al.

Docket Number

Group Art Unit

Filing Date

071308.0446

3682

July 9, 2003

**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
A.	5941137	8/24/99	Beer et al.	74	606R	3/16/98
B.	5966291	10/12/99	Bäumel et al.	361	707	11/3/97
C.	6302190	10/16/01	Clamp et al.	165	80.4	6/29/99
D.	2002/0088304	7/11/02	Thorum et al.	74	606	8/23/01
E.						
F.						
G.						
H.						
I.						
J.						
K.						
L.						

**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO
M.							
N.							
O.							
P.							
Q.							
R.							

**NON-PATENT DOCUMENTS**

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
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EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.